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EXAMINER

VU, THONG H

| ART UNIT | PAPER NUMBER |
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2142

DATE MAILED: 09/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/053,826

Applicant(s)

CHANG ET AL.

Examiner

Thong H Vu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-61 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-61 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 January 2002 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/18/02.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

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1. Claims 1-61 are pending.
2. This is a Continuation in part of application 08/944,668 [USP 6,381,633 B2].

Double Patenting

3. Claims 1-61 of this application conflict with claim 1-61 of Application No. 10/053827. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

Claims 1-61 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-61 of copending Application No. 10/053827. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-61 are rejected under the judicially created doctrine of double patenting over claims 1-36 of U. S. Patent No. 6,381,633 B1 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

(Patent '633. Claim 1) A method for managing messaging platforms on a messaging network, the method comprising:

- maintaining a messaging platform profile for a messaging platform on the messaging network in a master profile table, said messaging platform profile including a host ID unique to said messaging platform, an area of operation, an operational status defining the operational state of said messaging platform, and a token pool including at least one token to measure the cost of message delivery;

- storing a version of said master profile table in a global profile table held by each messaging platform on the messaging network;

- monitoring a messaging platform on the messaging network;

- updating said master profile table in response to said step of monitoring;

- updating said global profile table held by each messaging platform in response to said step of updating said master profile table, ensuring version consistency between said master profile table and each of said global profile tables; and

- using said operational status to determine whether a messaging platform may request delivery of a user message via the messaging network at an area of operation supported by a remote messaging platform.

(Application, Claim 1) A method for managing messaging platforms on a messaging network, the method comprising the steps of:

- maintaining a messaging platform profile for a messaging platform on the messaging network in a master profile table, said messaging platform profile including a host ID, an area of operation, an operational status, and a token pool;

- storing a version of said master profile table in a global profile table held by each messaging platform on the messaging network;

- monitoring a messaging platform on the messaging network;

- updating said master profile table in response to said step of monitoring;

- updating said global profile table held by each messaging platform in response to said step of updating said master profile table, ensuring version consistency between said master profile table and each of said global profile tables; and

- using said operational status to determine whether a messaging platform may request delivery of a user message via the messaging network at an area of operation supported by a remote messaging platform.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-7,19-21,22-31,32-38,52-61 are rejected under 35 U.S.C. § 102(e) as being anticipated Vaudreuil [5,621,727].

6. As per claim 52, Vaudreuil discloses a system for delivering information to a subscriber on a messaging system [Vaudreuil, a messaging system, abstract] the system comprising:

a messaging platform having means for receiving a mailbox ID [Vaudreuil, mailbox address, col 33 lines 50-65, Fig 16] and service information from a subscriber [Vaudreuil, information services, col 7 lines 33-50] and means for requesting from a master platform information corresponding to said service information, said master platform having means for communicating with an information source, said means for

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communicating responsive to said means for requesting by requesting information corresponding to said service information from said information source [Vaudreuil, the client-server, request-response communications, col 9 lines 25-35; interact with message stored through file server; a master database provides information services, col 9 lines 36-col 10 line 12, a master database, col 17 lines 30-38];

wherein said master platform responds to any information received from said information source by sending said information to said messaging platform [Vaudreuil, master database sends and receives information, col 25 line 65-col 26 line 19; col 28 line 50-col 29 line 37]; and

wherein said messaging platform converts said information to have a delivery format corresponding to a delivery format selected by said subscriber [Vaudreuil, message translation, col 8 lines 15-25; col 19 lines 2-27; 45-67]:

said messaging platform having means for providing said information in said delivery format to said subscriber when said subscriber accesses a mailbox corresponding to said mailbox ID [Vaudreuil, translate format and place in a mailbox, col 26 lines].

7. As per claim 53, Vaudreuil discloses said service information includes an information type [Vaudreuil, media type, col 27 lines 27-33], a delivery period [Vaudreuil, period of time, col 29 line 48-col 30 line 6], and a delivery format [Vaudreuil, translate format and place in a mailbox, col 26 lines].

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8. As per claim 54, Vaudreuil discloses said delivery format includes a voice delivery format [Vaudreuil, a voice messaging system, col 6 lines 27-50].
9. As per claim 55, Vaudreuil discloses said delivery format includes an email format [Vaudreuil email, col 5 lines 27-57].
10. As per claim 56, Vaudreuil discloses said delivery format includes a fax format [Vaudreuil, fax, col 5 lines 27-57].
11. As per claim 57, Vaudreuil discloses said master platform forwards said information received from said information source to said messaging platform only when said messaging platform has an in-operation status [Vaudreuil, master database and update status information, col 20 lines 15-20; col 26 line 62-col 27 line 3,65-col 28 line 12].
12. As per claim 58, Vaudreuil discloses said in-operation status is based on said operation schedule defined for said messaging platform [Vaudreuil, schedule, col 16 lines 28-52].
13. As per claim 59 Vaudreuil discloses said master platform delays sending said information received from said information source to said messaging platform when said

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messaging platform has a non-operational status (i.e.: non-subscriber) [Vaudreuil, non-subscriber, col 32 lines 2-20].

14. As per claim 60, Vaudreuil discloses said non-operational status is obtained when said token pool falls below a selected threshold as inherent feature of message status information such as processing, pending, failure, etc.

15. As per claim 61, Vaudreuil discloses said master platform converts said information received from said information source into an email format and sends said email formatted information to a mailbox supported by a messaging platform that corresponds to said mailbox ID, if an email format has been chosen as said delivery format [Vaudreuil, translate format and place in a mailbox, col 26 lines].

16. Claims 1-7,19-21,22-31,32-38 contain the similar limitations set forth of apparatus claim 52-61. Therefore, claims 11-7,19-21,22-31,32-38 are rejected for the similar rationale set forth in claims 52-61.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claims 8-18,39-49 are rejected under 35 U.S.C. § 103 as being unpatentable over Vaudreuil [5,621,727] in view of Weber [5,812,668].

18. As per claim 8, Vaudreuil discloses a method for maintaining a messaging network having a master platform and at least one messaging platform, the master platform having a master global routing table and each messaging platform having a global routing table, the master global routing table and each global routing table each holding a messaging platform entry for each messaging platform on the messaging network, the method comprising the steps of:

responding to each messaging platform on the messaging network that sends a (HELLO) message to the master platform, said (HELLO) message sent by each messaging platform at a selected interval which is defined in the messaging platform entry corresponding to each messaging platform source [Vaudreuil, the client-server, request-response communications, col 9 lines 25-35; interact with message stored through file server; a master database provides information services, col 9 lines 36-col 10 line 12, a master database, col 17 lines 30-38];

sending a (QUERY) message to a messaging platform on the messaging network that fails to send a (HELLO) message to the master platform within said selected interval [Vaudreuil, track down errors, repair errors, col 18 lines 1-25];

updating a messaging platform entry of said messaging platform in the master global routing table and the global routing table of each messaging platform on the messaging network [Vaudreuil, a global unique number, Internet addressing, col 21 lines 26-47], if said messaging platform fails to respond to said (QUERY) message, said

step of updating setting an operational status within said messaging platform entry to indicate a disabled status [Vaudreuil, update the status message, col 7 lines 15-32]; and using said operational status of a remote messaging platform to determine whether said messaging platform may send a user message using the messaging network to said remote messaging platform for delivery to an area of operation supported by said remote messaging platform [Vaudreuil, update the status message, col 7 lines 15-32; network remote procedure calls, col 10 lines 13-21].

However Vaudreuil does not detail each messaging platform entry having a host ID, an area of operation, an operational status, a token pool and HELLO message, QUERY message.

A skilled artisan would have motivation to improve the Vaudreuil operation and found Weber teaching. Weber discloses a method for secure the transmission of payment on network including using the HELLO message, QUERY message, host name or ID and token pool [Weber, Hello message, col 13 line 37-col 14 line 20; query message, token pool, col 63 lines 25-50; host name or ID col 133 lines 12-17]

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the technique of secure transmission over Internet as taught by Weber into the Vaudreuil's apparatus in order to utilize the different message types. Doing so would provide a secure and efficient process to verify a remote transaction on a global network.

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19. As per claim 9, Vaudreuil-Weber disclose providing the token pool of each messaging platform with an initial amount of tokens; debiting a debit amount from the token pool of a messaging platform that requests delivery of a user message at an area of operation supported by a remote messaging platform; and incrementing a credit amount to the token pool of said remote messaging platform in response to the delivery of said user message within said area of operation by said remote messaging platform [Weber, credit or debit transaction, col 15 lines 21-35].

20. As per claim 10, Vaudreuil-Weber disclose a step of updating a messaging platform entry of a messaging platform to have a disabled operation status in response to said messaging platform having a token pool amount that falls below a selected threshold as inherent feature of token pool.

21. Claims 11-18,39-41,42-49 contain the similar limitations set forth of apparatus claims 8-10. Therefore, claims 11-18,39-41,42-49 are rejected for the similar rationale set forth in claims 8-10.

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Thong Vu, whose telephone number is (703)-305-4643.

The examiner can normally be reached on Monday-Thursday from 8:00AM- 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *Jack Harvey*, can be reached at (703) 305-9705.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-9700.

Any response to this action should be mailed to: Commissioner of Patent and Trademarks, Washington, D.C. 20231 or faxed to :

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After Final (703) 746-7238

Official: (703) 746-7239

Non-Official (703) 746-7240

Hand-delivered responses should be brought to Crystal Park 11,2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

Thong Vu

Patent Examiner

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A handwritten signature in black ink, appearing to read 'Thong Vu', with a horizontal line underneath.